

## **REMARKS**

Upon entry of the present amendments, claims 7-12, 15, 19-39 and 43-48 are pending in this application. Claims 7-12, 15, 20, 22, 23-31, 34-39, and 43-48 have been amended for formal reasons as shown above. Claim 15 has also been amended to recite a proviso that the angiogenesis inhibiting compound is not thalidomide. Support for these amendments can be found in the application as originally filed specifically, for example, within Figures 1-5, Pages 14-17, and the claims as originally filed.

It is submitted that no new matter has been introduced by the present amendments and entry of the same is respectfully requested. By the amendments, Applicant does not acquiesce to the propriety of any of the Examiner's rejections and does not disclaim any subject matter to which Applicant is entitled. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 U.S.P.Q.2d 1865 (U.S. 1997). Further, Applicant reserves the right to prosecute the subject matter of any canceled claim in one or more continuation, continuation-in-part, or divisional applications.

### **The Rejection under 35 U.S.C. § 102(b) Should be Withdrawn**

Claims 15, 19, 20, and 22 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by International Patent Publication WO 95/03807 to Billson et al. ("Billson"). Paper No. 20 at pages 2-3. Applicant respectfully traverses this rejection for the following reasons.

A prior art reference must disclose all of the limitations of a claim in order to anticipate that claim. See M.P.E.P. § 2131. There must be no difference between the claimed invention and the cited reference as viewed by one of ordinary skill in the art. *Scripps Clinic & Research Fdn. v. Genentech*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). Put another way, "[a] claim is anticipated and therefore invalid only when a single prior art reference discloses *each and every* limitation of the claim." *Glaxo Inc. v. Novapharm Ltd.*, 52 F.3d 1043, 1047, cert. denied, 116 S. Ct. 516 (1995) (citations omitted) (emphasis added).

In the event a reference does not explicitly teach all elements of a claim, anticipation can only be shown by inherency if, and only if, the cited reference makes it clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by one of ordinary skill in the art. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (citing *Continental Can Company USA Inc. v. Monsanto Company*, 948 F.2d 1264 (Fed. Cir. 1991)). Consequently, inherency cannot be established by probabilities or possibilities: "[t]he mere fact that a

certain thing may result from a given set of circumstances is not sufficient to support an assertion of inherency." *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 414 (C.C.P.A. 1939)). Therefore, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." M.P.E.P. § 2112, citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (*Bd. Pat. App. & Inter.* 1990).

Claim 15 has been amended to recite a proviso that the angiogenesis inhibiting compound is not thalidomide. Claims 19, 20, and 22 recite this proviso as well.

The Examiner alleges that Billson states that a variety of anti-angiogenesis agents can be combined in a composition or administered to a patient. Paper No. 20 at pages 2-3. Applicant respectfully disagrees. The Examiner has not demonstrated that Billson teaches, for example, the angiogenesis inhibiting compounds recited in the instant claims. Further, the Examiner has not demonstrated that one of ordinary skill in the art would conclude that Billson inherently teaches the angiogenesis inhibiting compounds recited within the instant claims. Applicant respectfully submits that Billson is deficient to support the present rejections under 35 U.S.C. § 102(b).

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 102(b) be withdrawn.

#### **The Rejection under 35 U.S.C. § 102(e) Should be Withdrawn**

Claims 15, 19, 20, and 22 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by United States Patent No. 5,770,589 to Billson et al. (the "'589 patent"). Paper No. 20 at pages 3-4. Applicant respectfully traverses this rejection for the following reasons.

Applicant respectfully points out that the rejection over the '589 patent is identical to the rejection under 35 U.S.C. § 102(b) over Billson, as Billson and the '589 patent are co-extensive. The Examiner has not demonstrated that the '589 patent teaches the angiogenesis inhibiting compounds recited in the instant claims. Further, the Examiner has not demonstrated that one of ordinary skill in the art would conclude that either Billson or the '589 patent inherently teaches each and every element of the instant claims. Like Billson, the '589 patent is deficient to support the present rejections.

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 102(e) be withdrawn.

### **The Rejection under 35 U.S.C. § 103(a) Should be Withdrawn**

Claims 7-12, 15, 19-39 and 43-48 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Billson alone or in combination with United States Patent No. 5,348,942 to Little II *et al.* ("Little"). Paper No. 20 at pages 5-8. Applicant respectfully traverses the rejection for the reasons discussed below.

In order to properly determine a *prima facie* case of obviousness, an examiner "must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." M.P.E.P. §2142. This is important, as "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." *Id.* Three basic criteria must then be met: first, there must be some suggestion or motivation to modify or combine the cited references; second, there must be a reasonable expectation of success; and third, the prior art references must teach or suggest all the claim limitations. *Id.* at §2143. With regard to the first criterion, it is important to recognize that the "mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *Id.* at 2143.01 (citing *In re Mills*, 916 F.3d 680 (Fed. Cir. 1990)).

Claims 7-12, 15, 19-39 and 43-48 relate to compositions and/or methods of treatment of angiogenesis and angiogenesis related diseases using an angiogenesis inhibiting compound and an antiinflammatory compound.

The Examiner appears to broadly allege that one of ordinary skill in the art would be motivated by the teachings of Billson alone or in combination with the teachings of Little to utilize an anti-inflammatory agent along with an anti-angiogenesis agent and/or to produce a composition comprising an anti-inflammatory agent and an anti-angiogenesis agent. Paper No. 20 at pages 5-8. Applicant respectfully traverses.

First, the Examiner has not provided the requisite support, based on the references of record, for the contention that one having ordinary skill in the art "is provided with the motivation to utilize any agent that is an angiogenesis agent [sic], which would obviously embrace thalidomide as well as its derivatives and analogues." Paper No. 20 at pages 5, 7. The Examiner has not demonstrated that Billson teaches or suggests the angiogenesis inhibiting compounds recited in the instant claims. It is not seen how Little remedies the deficiencies of Billson in this regard; indeed, the Examiner has not demonstrated that Little teaches or suggests the angiogenesis inhibiting compounds recited in the instant claims.

Second, the Examiner has not provided the requisite support, based on the references of record, for the contention that it would be “obvious to the skilled artisan to treat ... various ... conditions with angiogenesis inhibitors.” Paper No. 20 at pages 6, 7-8. To support this contention, the Examiner appears to have improperly cited the present application, rather than the references of record. Paper No. 20 at page 6. Indeed, this tactic reflects the Examiner’s use of a type of hindsight reconstruction long proscribed by the courts.

Further, the Examiner has not provide the requisite support, based in the references of record, for the contention that the skilled artisan would have been motivated to utilize and substitute other agents, as well as their respective derivatives and analogues, as long as the agents maintain the pharmaceutical properties of anti-inflammatory agents as well as anti-angiogenesis agents. Paper No. 20 at pages 6, 7, 8. The Examiner appears to improperly suggest, in other words, that it would have been obvious for one of ordinary skill in the art to try any number of compounds in a therapeutic method or in a therapeutic composition. For this reason alone, the pending rejections under 35 U.S.C. § 103 must be withdrawn, for it is well settled that whether or not something may have been “obvious to try” cannot be considered in a determination of obviousness. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1380 (Fed. Cir. 1986) (citing *Jones v. Hardy*, 727 F.2d 1524, 1530 (Fed. Cir. 1984) (“obvious to try” is improper consideration in adjudicating obviousness issue)).

Finally, Applicant respectfully submits that the Examiner has not met the requirement of demonstrating why or how one of ordinary skill in the art would have been motivated to combine Billson with Little to make or use the claimed inventions. Similarly, the Examiner has not met the burden—imposed by the Federal Circuit—of demonstrating how the combination provides one of ordinary skill in the art with a reasonable expectation of success in making or using the claimed inventions.

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) be withdrawn.

**CONCLUSION**

Applicant respectfully requests that the above remarks and accompanying documents be entered in the present application file. An early allowance of the present application is respectfully requested.

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Respectfully submitted,

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